



Attorney Docket No. 0756-2188

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Shunpei YAMAZAKI et al.

Serial No. 09/619,479

Filed: July 19, 2000

For: SEMICONDUCTOR DEVICE AND
INTEGRAL IMAGE
RECOGNITION/DISPLAY
APPARATUS

) Group Art Unit: 2871

) Examiner: T. Rude

) CERTIFICATE OF MAILING

) I hereby certify that this correspondence is being
) deposited with the United States Postal Service
) with sufficient postage as First Class Mail in an
) envelope addressed to: Commissioner for Patents,
) P.O. Box 1450, Alexandria, VA 22313-1450, on
) July 29, 2004.

) Adeline M. Stamps

)

RESPONSE

Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Official Action mailed March 29, 2004, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to July 29, 2004. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statement filed on July 19, 2000.

Claims 1-25 and 29-37 are pending in the present application, of which claims 1, 4, 8, 10, 12, 15, 19, 21 and 23-25 are independent. The Applicants note with appreciation the allowance of claims 10, 11, 21 and 22. For the reasons set forth in detail below, all claims are believed to be in condition for allowance and favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 1, 2, 8, 12, 13, 19, 23, 25, 29, 31, 32, 34, 35, and 37 as anticipated by U.S. Patent No. 5,812,109 to Kaifu et al. As stated in MPEP § 2131, to establish an anticipation rejection, each and every element

as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The pending claims relate to the display device comprising a pixel portion (or a plurality of pixel portions) having an active device and a pixel electrode comprising two layers, and a sensor portion (or a plurality of sensor portions), wherein one of the layers comprises a reflecting material and the other of the layers comprises a light-transmitting material.

The Official Action alleges that Kaifu discloses an integral image recognition/display apparatus comprising a pixel portion (or a plurality of pixel portions) D11, each having an active device T11, and arranged in matrix and each having a pixel electrode comprising the layer of aluminum, and n-doped silicon 5 over an active matrix substrate 1; and a sensor portion (or a plurality of sensor portions) S11, arranged in matrix over said matrix substrate.

It should be noted, however, that Kaifu teaches in column 7, lines 32-37 that a liquid crystal display element (indicated by symbol D11) is configured with an orientation layer 81, a transparent common electrode 83, and an upper glass 84, which does not include the TFT (indicated by symbol T11). Furthermore, it is apparent from Fig. 4A, that the TFT (T11) is independent from the liquid crystal display element (D11). It is respectfully submitted that the pixel portion D11 of Kaifu does not include TFT T11 as asserted in the Official Action and thus Kaifu does not disclose a pixel portion having an active device as recited in the pending claims. Thus, it is respectfully submitted that Kaifu cannot anticipate the claims. Reconsideration is requested.

Paragraph 3 of the Official Action rejects claims 3-7, 9, 14-18, 20, 24, 30, 33, and 36 as obvious based on the combination of Kaifu and U.S. Patent No. 5,585,817 to Itoh et al.

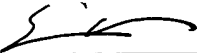
As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or

motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

It is respectfully submitted that Itoh does nothing to overcome the deficiencies noted above with respect to Kaifu. That is, the pixel portion D11 of Kaifu does not include TFT T11 as asserted in the Official Action. Therefore, it is respectfully submitted that a *prima facie* case of obviousness cannot be maintained for the same reasons as stressed above. Favorable reconsideration is requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789